

Application Serial No. 10/521,192
Docket No. 1093-120 PCT/US
Response to October 30, 2007
Non-Final Office Action

REMARKS

The Non-Final Office Action mailed October 30, 2007 and the references cited therein have been carefully considered. Claims 1-17 are now pending in the application. Claims 1 and 9 have been amended and new Claims 18-24 have been added to clarify that which Applicants regard as the invention. The amendments to Claims 1 and 9 and the additions of new claims 18-24 correspond to language contained in the specification or shown in the drawings. Similarly, the amendments to the specification and drawings correspond to language contained in the claims as originally filed. Thus, no new matter has been added by the amendments.

Applicant appreciates and respectfully acknowledges the telephone interview that took place between Examiner Jamila Williams, Supervisory Examiner Monica Carter and the undersigned on February 25, 2008. While no formal agreement was reached, the following prior art references were generally discussed in relation to the rejections made in the Office Action dated October 30, 2007:

U.S. Patent No. 6,808,792 to **Weber**; and

International Application WO 93/12940 to **Vermeulen** et al.

Objections to the Drawings

In the Office Action, the drawings are objected to under 37 C.F.R. 1.83(a) for not showing every feature of the invention specified in the claims. Accordingly, Applicant has presented a "REPLACEMENT SHEET" of drawings to replace page 2 of the drawings. In particular, Figure 5 of the drawings has been amended to now show element 60 (corresponding to a window opening), element 64 (corresponding to markings) and element 68 (corresponding to printing). Also, corresponding amendments are presented herein to the specification. In particular, on page 8 of the specification, reference and a description of new elements 60, 64, 68 was added. On page 10 of the specification, further reference was added to new elements 64, 68.

It should be noted that the amendment to the body of the last paragraph starting on page 10, which changes reference numeral "46" to now read --56--, was done to correct a typographical error. As shown in Figure 7, the "printing 58" is applied to the surface of adhesive layer 56.

In view of the foregoing, Applicant respectfully requests the amendments to the Specification and Drawings be entered and that the objections to the drawings be withdrawn. Accordingly, reconsideration and allowance are respectfully solicited.

Claim Rejections under 35 USC § 112

In the Office Action, Claims 1-17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting such phrases as "or the like", "such as" and

“(barcodes)”. Applicant has hereby deleted such phrases and therefore requests that this rejection be withdrawn.

Claim Rejections under 35 USC § 103

Claims 1-4, 6-9 and 16-17 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,808,792 to **Weber** in view of the published International Application WO 93/12940 to **Vermeulen** et al. Additionally, Claim 5 was rejected as being unpatentable under 35 U.S.C. §103(a) over Weber and Vermeulen as above, and further in view of U.S. Patent No. 5,103,583 to **VanErmen**. Further, Claims 10-15 have been rejected as being unpatentable under 35 U.S.C. §103(a) over Weber and Vermeulen as above, and further in view of U.S. Patent No. 4,533,160 to **Malone**. Applicant respectfully traverses these rejections.

In the present invention, the adhesive layer (56) is not arranged on the side of the decorative layer arrangement (22) directed to the base film (20). In this way, the adhesive is on the side of the carrier layer which fixes the transfer film with the rest of the page of the security document, as shown in Figures 1-4. Furthermore, the transfer film (18), including a base film (20) and a decorative layer arrangement (22), is incorporated into the security document (10) by the same means of fixing or adhesive used to join together the pages (14) of the document (10). Neither of these features are disclosed in the prior art of record.

The instant invention has practical applications not achieved by the prior art. A security document made in accordance with the invention can be presented to an agency or an authority

that issues, for example, passports. The agency can print personalized information on a page of the security document adjacent to the transfer film, which is fixed in the security document. Thus, the decorative layer arrangement is arranged between the base film and this page of the security document. Then the security document can be treated by lamination. Thus, the decorative layer arrangement would then be affixed to the page, along with the personalized information, thereby protecting it from further alterations or changes. After the decorative layer is transferred to the page of the security document, the base film can be detached from the decorative layer arrangement. This is done by separating at least a portion of the base film from the security document, leaving the decorative layer arrangement behind. Therefore, the decorative layer arrangement adheres firmly, in a desired orientation and location, over the corresponding page of the security document along with the personalized information.

The present invention achieves several advantages that are not taught or suggested in the prior art. The arrangement as described above and defined by the claims simplifies and facilitates the handling of a security document, provided with a transfer film. It avoids special handling and/or management of the security document. Also, the level of security associated with the document is increased since the page(s) and the transfer film, with a security element protecting the personalized part of the document, forms a common unit before personalization. Furthermore, the invention secures the proper arrangement of security elements at each page of the security document and in the desired location and orientation. These concepts are neither disclosed nor suggested by the prior art references of record.

Weber discloses a specific type of transfer foil which has a carrier foil 1, a base film 3 and a hot stamping foil 6 laminated together by adhesive layers 2 and 4 (Fig.1). Furthermore, Weber discloses how to transfer the transfer layers of this transfer foil to a substrate 8, which is a document (see Fig. 2). However, Weber does not disclose or suggest incorporating, securing or binding a transfer foil into a multi-page document, such as a passport or other security document. While Weber suggests that a transfer foil can be used to apply a decorative layer to a multi-page document, such as a passport, it does not teach or suggest fixing the transfer foil itself to the document. Once the decorative layer of Weber is adhered to the substrate, the release layer previously holding the base film and the decorative layer together, softens so that the base film is easily removed (See Weber Col. 7, lines 25-31). Thus, in Weber while the decorative layer gets secured to the document, the transfer film (including both a base film and a decorative layer) is never secured thereto. Furthermore, Weber certainly does not disclose or suggest fixing the transfer foil to the security document using the same means of fixing or adhesive securing the multiple pages of the document.

Figures 1 and 2 of Weber disclose a specific transfer foil which is not part of an individualized security document. Figure 3 of Weber discloses a substrate 8 of a security document with a layer arrangement applied on it. If the substrate 8 is considered a base film, the adhesive layer 56 is not arranged on the side of the decorative layer arrangement remote from the base film, but rather between the decorative layer arrangement and the base film.

Vermeulen teaches a passport booklet with multiple pages bound together. To protect printed matter representing the identification and verification data, Vermeulen suggests laminating a page of the booklet with a transparent resin sheet bearing an image. Thereafter, attempts to separate the printed matter or image from the booklet will seriously damage the information data (see Vermeulen page 1, third and forth paragraphs).

Consequently, a person of ordinary skill in the art combining the teachings of Weber and Vermeulen would not arrive at the present invention as recited in the claims, and particularly independent claims 1 and 21. While a skilled artisan might use the teaching of Weber to apply a decorative element to booklet as taught by Vermeulen, there is no teaching, motivation or suggestion to actually bind the entire transfer film, base and all, to the booklet. Thus, one would not bind the transfer film to the booklet, let alone actually use the same fixing or adhesive that binds the booklet to bind the transfer film.

Weber discloses a transfer foil that is used as a separate product to transfer a decorative element onto a substrate. Nowhere in the prior art is there a teaching or suggestion of securing or fixing a transfer film to a security document using the means of fixing that binds that document. Also, while Vermeulen discloses that a transparent resin sheet bearing or covering personalized information can be bound onto a page of a booklet, the sheet is added later through lamination. Therefore, both Weber and Vermeulen teach away from present invention as claimed.

VanErmen is cited for teaching a security document with a window or opening in its base film. Also, **Malone** is cited for teaching a security document with layered sheets separated by perforations. However, neither of these references teach or suggest incorporating a transfer film into a security document as recited in the claims, and particularly claims 1 and 21.

Applicant submits that the amended claims, particularly independent claims 1 and 21, are clearly distinguishable from the cited prior art references. Also, claims 2-20 and claims 22-24, which ultimately depend from Claims 1 and 21, respectively, are similarly patentable over the art of record by virtue of their dependence. Also, Applicant submits that Claims 2-20 and claims 22-24 define patentable subject matter in their own right. In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and allowance of the claims presented.

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If the Examiner has any questions or suggestions to expedite allowance of this application, she is cordially invited to contact Applicant's attorney at the telephone number provided.

Respectfully submitted,

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